

REMARKS

The Official Action of June 30, 2006, and the prior art relied upon therein, including the references newly cited and applied, have been carefully studied. The claims in the application are now claims 1, 2, 5-7, 10-13, 19-23, 25 and 28-33; these claims fully conform with §112 and define novel and unobvious subject matter under §§102 and 102, and therefore should be allowed. Applicants therefore again respectfully request favorable reconsideration and allowance.

Applicants respectfully request the PTO to change the PTO records to reflect the attorney docket number for applicants' new attorneys, i.e. to please change in the PTO records the attorney docket number from the old docket number to "LEVI=4".

A new rejection on double patenting has now been instituted. In this regard, claims 1, 2, 5-7, 10-12, 19-23, 25 and 28-31 have been rejected on the grounds of obviousness-type double patenting. Applicants also note that claim 26 has not been so rejected.

Claim 26 has now been deleted, but its subject matter has been introduced into each of the independent claims. Accordingly, such obviousness-type double patenting rejection need not be addressed at the present time. For the record, applicants do not agree with and therefore do not acquiesce in

the rejection.¹ The amendment has been made to advance prosecution in this long pending application, and not because applicants agree with the rejection. Thus, the amendments are made without prejudice to applicants' rights, including those rights under §§120 and 119, to pursue broader claims in a continuing application without any penalty whatsoever, if applicants choose to do so.

Claims 1, 2, 5-7, 10-13, 19, 21-23, 25, 26 and 28-31 have been rejected under the first paragraph of §112. The rejection is respectfully traversed.

Again, applicants do not agree with the rejection, but have nevertheless made amendments above in an attempt to obviate the rejection, so as to advance prosecution in view of the long pendency of the present application. The amendments are therefore made without prejudice in favor of applicants' rights as expressed above.

For the record, applicants briefly note that the law is clear that an applicant may properly make explicit that which is implicit or inherent in the original disclosure, as pointed out in the preceding Reply at pages 8-11, respectfully repeated by reference. This is moreover supported in MPEP 2163.03 with reference to the fact that the "subject matter of the claim need not be described literally (i.e., using the same terms or *in haec*

¹ For example, applicants do not agree that it would have been obvious to modify the claims of Levi '506 in view of Kobayashi to reach the claimed subject matter.

verba) in order for the disclosure to satisfy the [written] description requirement" (italics in original; bracketed material added), and MPEP 2163.04 notes that the burden is on the examiner. Applicants maintain that the feature criticized in claim 1 and 19 is at least inherent if not implicit in the original disclosure; and the feature criticized in claims 21 and 23 is quite implicit from the original disclosure in view of the specific disclosure of Example 1, line 2, set forth in previously presented claim 26 and new claims 32 and 33.

Applicants also submit that the amendments presented in claims 1, 19, 21 and 23 do not constitute substantial changes in the claims; in other words, the meaning of the claims remains the same or substantially the same.

The comments in "Response to Arguments" section of the Office Action in the bottom paragraph on page 10 seem irrelevant to applicants. Simply because an applicant discloses plural embodiments does not mean that such applicant must claim all those embodiments. Thus, even if applicants' disclosure were interpreted by the person skilled in the art to include polymers having very high molecular weights, that would not force the applicants to claim all such polymers. Moreover, it is clear from applicants' specification as a whole that the polymers selected must have properties which will give the desired results, and this implies the desirability of using low molecular weight polymers, which implication is reinforced by example 1.

Claim 23 has been further criticized for the recitation of the pH of 4.6 "or less". This has not been changed in claim 23. Applicants addressed this criticism in the last Reply at page 12, and applicants do not see that the examiner has answered or rebutted applicants' arguments in that respect. A pH of 4.5 is less than a pH of 4.6. Therefore, claim 23 is absolutely correct. Moreover, there is no reason why applicants should be compelled to provide a lower limit on the pH set forth in claim 23.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2, 5-7, 10-12, 19-23, 25, 26 and 28-31 have been rejected under §103 as obvious from Pacifici et al USP 5,039,481 (Pacifici) in view of Saeki et al USP 5,780,547 (Saeki) or Meadus et al USP 4,158,648 (Meadus). This rejection is respectfully traversed.

The rejection acknowledges that Pacifici, the primary reference, does not show a main and fundamental feature of the present invention, namely the provision of a sufficient quantity to form a biodegradable film of a non-toxic and ecologically safe, water soluble polymer. The secondary references have nothing to do with the art of Pacifici, and consequently there is no motive or incentive, reason or purpose, teaching or suggestion for the proposed combination, except that provided in applicants' own specification (but of course applicants' specification was

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not available to the person of ordinary skill in the art at the time the present invention was made).

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2, 5-7, 11, 19, 20, 25 and 26 have been rejected again as obvious under §103 from Kobayashi. The rejection is again respectfully traversed.

First, applicants respectfully repeat by reference the remarks of the last reply at pages 13-16. With respect, the rejection is based on the speculation that Kobayashi suggests sufficient polymer to form a real film, but there is no evidence that this is so. As opposed to the lack of evidence and the lack of a teaching in Kobayashi of such film forming, the present applicants have relied not only on their specification (which the PTO is obligated to accept in the absence of evidence or good reasoning to the contrary) which shows such real film forming, but also the declaration of Dr. Daren submitted with the last Reply which shows the inadequacy of Kobayashi.

The rejection states at the bottom of page 6 that the examiner has noted the use of the transitional phrase "consisting essentially of" in claim 1. The rejection is incorrect in stating that "the prior art composition has the same basic and novel characteristic", because (for one reason) Kobayashi does not use a sufficient amount of polymer as proven in Dr. Daren's declaration. There is even a lacking in Kobayashi the very basic

idea of forming a real film, and the whole idea in Kobayashi in the use of small quantities of polymer is to **resist fermentative decomposition** of the other components (column 2, lines 15-17). The polymer in Kobayashi is therefore something in the nature of a protectant, but again is not sufficient for applicants' purpose and as recited in applicant's claims.

In the "Response to Arguments" section of the office action at the bottom of page 9, the PTO denigrates Dr. Daren's declaration. This it may not properly do, as the declaration is evidence!² The purpose of the declaration is to show the insufficient quantity of the polymer taught by Kobayashi, and the declaration does that. Again, it is improper to speculate, contrary to the evidence, that Kobayashi uses or teaches an amount sufficient of polymer to reach applicants' claimed composition.

As regards the recitation in claim 1 of "at least 0.1%" of the polymer, the PTO has overlooked the other recitations in the claim that the polymer is "present in an amount sufficient for forming, upon drying, a thin film vapor barrier on the excrement" (claim 1). This is not taught by Kobayashi. Thus, the rejection again is incorrect where it implies, at the middle of page 11, that there is no difference in the amount of polymer claimed over that taught by Kobayashi.

² Please not *In re Khelghatian*, 150 USPQ 661, 663, footnote 2 (CCPA 1966), where the Court stated: "We... remain of the view that the law requires consideration of *all evidence*, properly submitted, bearing on the question of obviousness." (emphasis in original)

As regards the repeated reliance on *In re Aller*, 105 USPQ 233, 235 (CCPA 1955), applicants addressed this in the last Reply at page 15 thereof.³ Applicants have produced a new result, one absolutely not produced by Kobayashi in spite of the speculation by the PTO to the contrary. Again, it is not proper for the PTO to brush aside or essentially ignore evidence, and Dr. Daren's declaration is evidence.

In addition to the crucial distinctions previously claimed and noted above and previously, applicants' invention makes use of regular tap water (example 1) and does not require any special treatment of the water. Kobayashi, on the other hand, because the polymer is used in such small quantities and for an entirely different purpose, namely to provide resistance to fermentative decomposition, teaches that pure water should be used. Please note the paragraph spanning columns 9 and 10, where Kobayashi states as follows:

The concentration of the water-soluble organic polymer used in this invention is 0.05 to 5 ppm, preferably 0.1 to 20 ppm, most preferably 0.5 to 5 ppm, as solids in the aqueous medium. **It is very important to prevent biodegradation of the polymer and to take measures so as to maintain the level of the molecular weight of the polymer. For this purpose it is desirable to sterilize water for dilution by boiling or the like and to**

³ Please see *In re Yates*, 211 USPQ 1149, 1151, footnote 4 (CCPA 1981) where the Court, in reference to *In re Aller*, stated: "The problem, however, with such "rules of patentability"... is that they tend to becloud the ultimate legal issue - obviousness - and exalt the formal exercise of squeezing new factual situations into pre-established pigeon holes. Additionally, the emphasis upon routine experimentation is contrary to the last sentence of §103."

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reduce the level of the dissolved oxygen, preferably to zero. Preferably, a preservative or antiseptic is added to the diluting water in a concentration within the range legally stipulated.... Furthermore, to prevent inclusion of putrefying bacteria, enzymes and/or decomposing bacteria, it is preferred to control devices used in the dissolution, dilution, mixing, transportation, storing and filling of the polymer and in the deodorizing operation carefully throughout the entire operation.
(Emphasis added)

The present invention thus further distinguishes over Kobayashi in this respect as well, the "tap water" recitation of previous claim 26 having now been incorporated into each of the independent claims.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2, 5-7, 11, 19, 22, 25 and 29-31 have been rejected under §103 as obvious from Kobayashi in view of Suzuki. This repeated rejection is again respectfully traversed.

Claim 26 has not been included in this rejection, and thus such rejection need not be addressed at the present time in view of the incorporation of claim 26 into each of the independent claims.

Nevertheless, for the record, applicant respectfully repeats by reference the Remarks of the preceding Reply at page 16 thereof, which refers to a still earlier Reply.

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Withdrawal of the rejection is in order and is respectfully requested.

Claims 11-13 and 28 have been rejected as obvious under §103 from Kobayashi in view of Shimizu. This rejection, also repeated, is respectfully traversed.

Again, claim 26 is has not been included in this rejection, and applicants therefore need not address it at this time. To the extent necessary or desirable, applicants respectfully repeat by reference what is stated at page 20 of the Reply filed December 29, 2004, namely that Shimizu does not make up for the deficiencies of Kobayashi, and therefore the proposed combination would not reach any of applicants' claims.

Withdrawal of the rejection is in order and is respectfully requested.

In an attempt to avoid an unduly long Reply, applicants have shortened their remarks. For the record, any points of the PTO which applicants have not fully addressed in the Remarks above to the outstanding Office Action are believed to have been generally covered, and are not to be taken as any admission of applicants' agreement. Applicants believe they have fully responded.

Applicants believe and submit that the claims define patentable subject matter, and applicants therefore again respectfully request favorable reconsideration and allowance.

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However, if the examiner maintains her position that the present claims are not patentable, applicants hereby request a personal face-to-face interview BEFORE issuance of a further Office Action, and applicants request that examiner to call undersigned so that such an interview can be scheduled.

Respectfully submitted,

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